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JUNE 26, 1997

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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Federated Department Stores, Inc.
v.
Rosella S. Trombetta

Opposition No. 94,008
to application Serial No. 74/324,855
filed on October 23, 1992

Daniel Ebenstein and Chester Rothstein of Amster, Rothstein & Ebenstein for Federated Department Stores, Inc.

Lowell J. Gordon for Rosella S. Trombetta.

Before Cissel, Quinn and Walters, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application has been filed by Rosella S. Trombetta to register the mark IN SYNC for "men's, women's and children's clothing, namely, shirts, T-shirts, shorts, pants, jeans, shoes, sneakers, blouses, skirts, vests, sweaters, jackets, bras, briefs, pajamas, dresses,

bodysuits, socks, scarves, ties, coats, nightgowns, gloves, belts and hats."[1]

Registration has been opposed by Federated Department Stores, Inc. under Section 2(d) of the Act on the ground that applicant's mark, when applied to applicant's goods, so resembles opposer's previously used mark IN SYNC for young men's clothing and retail store services in connection with the sale of such clothing, as to be likely to cause confusion.

Applicant, in her answer, denied the salient allegations of likelihood of confusion.

The record consists of the pleadings; the file of the involved application; trial testimony (with related exhibits) taken by each party; portions of a discovery deposition,[2] applicant's answers to two of opposer's interrogatories and an excerpt from a printed publication,[3]

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[1]Application Serial No. 74/324,855, filed October 23, 1992, alleging a bona fide intention to use the mark in commerce.

[2]Opposer, on March 4, 1996, filed a motion to allow the introduction into evidence of portions of the discovery deposition of Robert A. Edis, a non-party to this proceeding. For the reasons set forth in opposer's motion, and inasmuch as applicant has not objected thereto (in fact, applicant suggested that opposer take Mr. Edis' deposition), the motion is granted. Trademark Rules 2.120(j)(1) and 2.127(a).

[3]We are unsure as to whether the audit report, identified as "Exhibit C" in the notice of reliance, is a "printed publication" as contemplated by Trademark Rule 2.122(e). That is to say, opposer has provided no information regarding whether the report is "available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue" in this proceeding. Nevertheless, applicant did not object to this evidence and, accordingly, we have considered it. Trademark Trial and Appeal Board Manual of Procedure, § 708. Even if not considered, we would reach the same result in this case.

all made of record by way of opposer's notice of reliance. Only opposer filed a brief on the case.[4] An oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods.

In the present case, the marks are identical. Further, as demonstrated by the record, opposer's and applicant's marks are used on identical and/or substantially similar clothing items. Moreover, opposer's retail store services involving young men's clothing are substantially similar to applicant's clothing items.

In view of the above, this case turns on the question of priority. Opposer introduced the testimony, together

[4]Opposer raises, for the first time in its brief (pp. 12-13), issues regarding applicant's first use. More specifically, opposer alleges that the first sales were not made by applicant and that the first use was merely ornamental. To the extent that opposer is raising these issues as additional claims for relief, suffice it to say that the notice of opposition was not amended accordingly, and the issues were not tried, either expressly or implicitly, by the parties. Fed. R. Civ. P. 15(a) and (b). See: Trademark Trial and Appeal Board Manual of Procedure § 321. In any event, inasmuch as the involved application is based on an intention to use, opposer's use, in order to prevail on priority, must predate the filing date of the application (that is, applicant's constructive use date). Thus, the bona fides of applicant's later use are irrelevant to the priority question.

with related exhibits, of Carey Watson, a senior vice president of marketing with Burdine's, a chain of stores owned by opposer. Mr. Watson detailed the adoption and continuous use of the mark IN SYNC since April 1991, that is, prior to the earliest date upon which applicant can rely. Mr. Watson testified that opposer began using the mark IN SYNC as the name of the young men's clothing department in its Burdine's stores located throughout Florida. Later, opposer expanded use of its mark IN SYNC to other department stores it owned in the mid-west, the south and the southeast. The mark has appeared on point of sale signs, and in advertisements and direct mailings.[5]

We find that the record clearly establishes opposer's priority of use in connection with clothing and retail store services involving clothing.

We conclude that consumers familiar with opposer's previously used mark IN SYNC for retail store services involving young men's clothing and items of young men's clothing would be likely to believe, upon encountering applicant's mark IN SYNC for men's, women's and children's clothing items, that the goods and services originated with or were somehow associated with or sponsored by the same entity.

Decision: The opposition is sustained and registration to applicant is refused.

[5]The signs, as shown, for example, in opposer's exhibit nos. 11 and 14, qualify as displays associated with the goods.

R. F. Cissel

T. J. Quinn

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board